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# Color Blocking: How the Harmonization of Color Protection May Catalyze Color Depletion in Global Markets

ARSHA HASAN\*

## ABSTRACT

*The Qualitex decision in 1995 inspired trademark reformation and harmonization worldwide for the protection of color marks. While protecting color trademarks has not created issues of market entry in domestic markets, the growth in the number of transnational market participants and an increased utilization of non-traditional branding may catalyze color depletion in international trade. After exploring how current advertising expenditure requirements and distinctiveness requirements affect the registrability and protection of a color mark, this Note offers potential global reforms to help minimize hurdles for small-scale transnational participants and the threat of international color depletion. Specifically, due to consumers' increasing exposure to international brands through e-commerce, courts should give more deference to survey results on Internet platforms to establish distinctiveness in the brand's relevant customer base. The proposals in this Note will benefit trademark owners and potential transnational market participants by ensuring that consumer confusion is based on actual market practices, which will in turn prevent color depletion by keeping widely used colors in the public domain. Ultimately, by remaining conscious of the facts and issues presented in this Note, attorneys, legislators, and trademark owners can ensure fair market competition and mitigate color depletion from taking place in transnational trade.*

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## INTRODUCTION

The principal purposes of a trademark are to protect the public from confusion or deceit as to the source of their goods as well as to protect the manufacturer's goodwill and reputation earned from its products.<sup>1</sup> Trademarks are defined by the Lanham Act as any "word, name, symbol, or device, or any combination thereof"<sup>2</sup> that indicates the source of goods, and serves three important functions: protecting consumers from confusion, protecting the trademark owner's investment, and identifying the source of the goods or services to ensure consistent quality and to reduce a consumer's search costs.<sup>3</sup> Over the past 150 years, trademarks have come to symbolize important eras in popular culture. During this transition, trademarks have begun to serve as a focal point in our overall social experiences and are valued for the cultural meaning we assign to the mark.<sup>4</sup> Accordingly, trade symbols have progressively come to incorporate the iconic shapes, sounds, textures, and scents associated with their respective companies, and are now recognized as "nontraditional trademarks."<sup>5</sup> Coca-Cola bottles,<sup>6</sup> the roar of MGM's lion,<sup>7</sup> and the scent of Plumeria blossoms on thread<sup>8</sup> all act as trademarks today. However, no nontraditional trademark has acted as powerfully as an advertising tool, incited as much contention, and inspired as much debate as the color mark—the flash of Louboutin red<sup>9</sup> as a woman walks down the street, the glimpse of Tiffany's blue<sup>10</sup> as a man gets down on one knee, and the pop of Veuve Clicquot orange<sup>11</sup> from across a polo field are all colors that are recognized around the world and fiercely protected in today's global markets.

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1. See *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 215 (2d Cir. 2012).

2. 15 U.S.C. § 1127 (2012).

3. See BRENT A. OLSEN, 20A1 MINN. PRAC., BUSINESS LAW DESKBOOK §16:1 (2015), available at 20A1 MNPRAC § 16:1 (Westlaw).

4. See MARK D. JANIS, TRADEMARK AND UNFAIR COMPETITION LAW IN A NUTSHELL 10 (2013).

5. See Hung Nguyen & Adam Lis, *Canada Opens Up to Registration of Nontraditional Trademarks*, LANDSLIDE Nov./Dec. 2012 at 48, 49. Shapes, sounds, scents, and colors are all protected by the Lanham Act as indicators of source due to their categorization as symbols or devices capable of carrying secondary meaning. See, e.g., *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995); Nguyen & Lis, *supra* note 5, at 51 (describing the MGM lion's roar as a famous sound mark in the United States).

6. Registration No. 696,147.

7. Registration No. 1,395,550.

8. Registration No. 1,639,128.

9. Registration No. 3,361,597.

10. Registration No. 2,359,351.

11. Registration No. 2,052,302.

In the past twenty years, *Qualitex Co. v. Jacobson Products Co.*<sup>12</sup> has influenced trademark reformation and harmonization worldwide, due to its “stunning breakthrough for nontraditional [trade]marks.”<sup>13</sup> Yet when the *Qualitex* decision came down, the American legal community criticized the holding<sup>14</sup> due to the possible repercussions of protecting singular color marks<sup>15</sup> in trademark law, and scholars were unsure of how the law would apply to future cases, fearing that color depletion and issues of shade confusion would arise and wreak havoc in courts.<sup>16</sup> These fears were largely unfounded in local markets—technological innovations in the chromatic spectrum, modifications to the registration process, and subsequent case holdings prevented color depletion and shade confusion from manifesting in domestic trade. However, the increasing trend in utilizing color per se in cross-cultural branding and the litigious nature of the corporations looking to protect their global presence may now begin to catalyze color depletion in international markets.

This Note will argue that, although time has shown that color depletion will not manifest in local markets, the rapid growth of the global economy and the growth in the number of transnational market participants has the potential to catalyze color depletion internationally. In addition, the effort to harmonize color mark protection laws is only further impetus to color depletion in transnational markets due to the sheer number of market participants aiming to capitalize on color branding. Furthermore, new market entrants and small-scale companies are facing additional hurdles due to the large investments that are expected by courts to demonstrate brand establishment in an industry, creating a litigious atmosphere and resulting in David-and-Goliath-esque court cases and color mark turf wars around the globe.

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12. *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995).

13. Jerome Gilson & Anne Gilson LaLonde, *Cinnamon Buns, Marching Ducks and Cherry-Scented Racecar Exhaust: Protecting Nontraditional Trademarks*, 95 TRADEMARK REP. 773, 782 (2005).

14. See, e.g., Elizabeth A. Overcamp, Recent Development, *The Qualitex Monster: The Color Trademark Disaster*, 2 J. INTELL. PROP. L. 595 (1995).

15. Color marks are defined by the Trademark Manual of Examining Procedure (TMEP) as a mark that “consist[s] *solely* of one or more colors used on particular objects” as a protectable trademark. TMEP § 1202.05 (5th ed. Sept. 2007).

16. The theory of color depletion relies on the assumption that only a limited number of colors exist in our world, which opens up the opportunity for manufacturers to monopolize each available color and thus foreclose the market to newcomer brands. See Overcamp, *supra* note 14, at 598. The concept of shade confusion rests on the contention that litigation will become frustrated by having to make difficult determinations as to whether two shades are similar enough to cause trademark confusion. See *id.* This argument was supported by the trademark registration system at the time, which did not provide a space to supply color samples to help describe the mark. *Id.*

This Note will first examine how courts and scholars reacted to the *Qualitex* decision, how it was expected to influence local markets, and why each fear was resolved through various technological developments and by an increasing utilization of annual color trend forecasts. This Note will then explore and analyze how the global adoption of the *Qualitex* decision is affecting foreign trade markets and how subsequent case law has created hurdles for smaller-scale companies attempting to protect color marks. The discussion will conclude with the argument that the competing interests for market entry in the global market, the threat of color depletion, and the global need for nonverbal indicators can be balanced. Consideration can readily be given to small-scale players on local and international platforms by considering circumstantial evidence that does not rely primarily on advertising expenditures and product sale volume to determine if secondary meaning in a mark exists. Instead, because our society is gravitating toward the Internet to research and purchase goods, courts should put more emphasis on cross-national digital communication, brand communities, and global consumers as the appropriate universe for determining the scope of trademark subject matter. In addition, it is inevitable that a form of discord in the protection of particular marks will have to continue in different jurisdictions to maintain a harmonious equilibrium and help prevent international color depletion from taking place, which will be accomplished through the interaction between secondary meaning requirements and differing perceptions in various cultures across the globe.

### I. THE *QUALITEX* DECISION

During the 1980s and '90s, the world watched as the "liberalization of markets took place, world trade and foreign direct investment increased, and the waves of global mergers accelerated."<sup>17</sup> By the mid-nineties, intangible assets such as trademarks were being valued by investors to count for more than 50 percent of a company's net worth.<sup>18</sup> In fact, strong brands became more than just an asset—it was often viewed as a company's single most valuable property.<sup>19</sup> With a new focus on the consumption of brand goods as a mode of self-expression,

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17. Teresa da Silva Lopes & Mark Casson, *Entrepreneurship and the Development of Global Brands*, 81 BUS. HIST. REV. 651, 655 (2007).

18. See David Haigh & Jonathan Knowles, *Brand Valuation: What It Means and Why It Matters*, IAM BRANDS BOARDROOM, 2004, at 18, 18, available at [http://brandfinance.com/images/upload/2004\\_05\\_brand\\_valuation\\_iam.pdf](http://brandfinance.com/images/upload/2004_05_brand_valuation_iam.pdf).

19. See Jerre B. Swann, Sr. et al., *Trademarks and Marketing*, 91 TRADEMARK REP. 787, 807 (2001).

American consumers began to focus on material goods at unprecedented rates. Data illustrates that between the 1970s and 1990s, individuals began increasingly to view material goods as necessities instead of as luxury items.<sup>20</sup> It became incontestable that in many instances, the color *was* the brand,<sup>21</sup> and gave companies a direct interest in securing the ability trademark their signature colors. When *Qualitex* reached the Supreme Court, many companies—with the support of intellectual property associations<sup>22</sup>—finally had the opportunity to speak out and lobby to protect their interests.<sup>23</sup> Furthermore, international commerce had grown substantially in the past century and was expected to take a giant leap forward with the advent of the Internet and its mainstream use. This gave the United States a direct interest in the impending *Qualitex* decision, as the country was expected to address the proper protection afforded to trademarks in international treaty organizations.<sup>24</sup> The Clinton administration began to put pressure on the Supreme Court to decide on the issue of color per se because the United States had already advocated in treaty negotiations (such as those for the North American Free Trade Agreement (NAFTA)) that other countries recognize the right to trademark color per se.<sup>25</sup>

In 1994, after ten years of discord among federal circuit courts, the Supreme Court granted certiorari to resolve whether the *Qualitex* Company was entitled to a green-gold trademark as applied to press pads used in the dry cleaning industry.<sup>26</sup> Although several courts agreed

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20. See JULIET B. SCHOR, *THE OVERSPENT AMERICAN: UPSCALING, DOWNSHIFTING, AND THE NEW CONSUMER* 10–19 (1998).

21. See Jill Morton, *Color & Branding*, *COLOR MATTERS* (2012), <http://www.colormatters.com/component/content/article/62-color-a-marketing/240-color-a-branding>.

22. See, e.g., Brief Amicus Curiae for the Bar Association of the District of Columbia in Support of Reversal, *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) (No. 93-1577); Brief of Amicus Curiae Intellectual Property Owners in Support of the Petitioners, *Qualitex*, 514 U.S. 159 (No. 93-1577); Brief of Amicus Curiae International Trademark Association in Support of Petitioner, *Qualitex*, 514 U.S. 159 (No. 93-1577).

23. See, e.g., Brief of Dr Pepper/Seven-Up Corporations as Amicus Curiae in Support of Appellant, *Qualitex*, 514 U.S. 159 (No. 93-1577), 1994 U.S. S. Ct. Briefs LEXIS 588, at \*4 [hereinafter Brief of Dr Pepper] (stating that Dr. Pepper has a direct interest in protecting its unique maroon color as an efficient indicator of source).

24. See Brief for the United States as Amicus Curiae Supporting Petitioner, *Qualitex*, 514 U.S. 159 (No. 93-1577), 1994 WL 16011874, at \*1–2 [hereinafter Brief for the United States Supporting Petitioner]; Linda Greenhouse, *High Court Ruling Upholds Trademarking of a Color*, *N.Y. TIMES*, Mar. 29, 1995, at D2.

25. See Brief for the United States Supporting Petitioner, *supra* note 24, at \*1; Greenhouse, *supra* note 24.

26. See *Qualitex*, 514 U.S. at 161.

with the holding in *In re Owens-Corning Fiberglas Corp.*,<sup>27</sup> and decided to reject the mere color rule,<sup>28</sup> the Ninth Circuit Court of Appeals directly contradicted the circuit majority and decided that the “better rule” would be that color alone could not form the basis of a trademark.<sup>29</sup> The court of appeals set aside the trial court judgment and cancelled Qualitex’s trademark registration. On review, however, the Supreme Court found that the Ninth Circuit committed legal error when it ruled that color was not trademarkable, in part by rejecting the theory of color depletion.<sup>30</sup>

Justice Breyer, delivering the opinion for a unanimous Court, found that no special legal rule existed that prevented color per se from serving as a trademark, and that the unique green-gold color was entitled to be registered as a trademark.<sup>31</sup> In reaching this conclusion, the Court applied a two-part test: whether the color had acquired a secondary meaning, and if the color was functional.<sup>32</sup> The Court reviewed two issues: color depletion, the theory that parceling out colors to manufacturers can create the danger of limiting—and eventually foreclosing—new entrants into a particular industry;<sup>33</sup> and shade confusion, an argument from institutional competence that courts should not be assigned the task of determining whether particular colors are substantially similar, due to the “difficult[y]” of making such

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27. *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985). The Federal Circuit broke sharply away from the principles relied upon by previous courts and created the modern trajectory for trademark protection of colors with its decision in *Owens-Corning*. The Federal Circuit rejected the Trademark Trial and Appeal Board’s holding that the color pink did not function as an indicative mark, stating that the court could not find “any compelling reasons that would preclude the registration and protection . . . of a color alone.” Glenda Labadie-Jackson, *Through the Looking Hole of the Multi-sensory Trademark Rainbow: Trademark Protection of Color Per Se Across Jurisdictions: The United States, Spain and the European Union*, 7 RICH. J. GLOBAL L. & BUS. 91, 93 (2008) (citing *Owens-Corning*, 774 F.2d 1116). The *Owens-Corning* court found that the color pink, as applied to fibrous glass insulation, was registrable in instances where the evidence showed that the color had acquired secondary meaning. See *Owens-Corning*, 774 F.2d at 1127-28.

28. The mere color rule, established in 1906, states “[w]hether mere color can constitute a valid trade-mark may admit of doubt.” *A. Leschen & Sons Rope Co. v. Broderick & Bascom Rope Co.*, 201 U.S. 166, 171 (1906).

29. *Qualitex Co. v. Jacobson Prods. Co.*, 13 F.3d 1297, 1302 (9th Cir. 1994), *rev’d*, 514 U.S. 159 (1995); see also Brief for the United States Supporting Petitioner, *supra* note 24, at 17-23.

30. See *Qualitex*, 514 U.S. at 168-69, 174.

31. See *id.* at 160-61.

32. See *id.* at 163-64.

33. See Hillel I. Parness, Note, *The Curse of the Pink Panther: The Legacy of the Owens-Corning Fiberglas Dissent and its Role in the Qualitex Supreme Court Appeal*, 18 COLUM.-VLA J.L. & ARTS 327, 330 (1994) (explaining the concept of color depletion).

a determination.<sup>34</sup> The Court found that the hindrance of competition and potential litigation *did not* outweigh the value in allowing companies to protect their brands. Furthermore, the Court refused to allow a blanket prohibition of color marks to solve what has now devolved only into an "occasional problem."<sup>35</sup> To fully understand this decision, it is first necessary to review the history of the case.

In 1957, the Qualitex Company began manufacturing and selling dry cleaning press pads in a unique, green-gold color.<sup>36</sup> This color was not chosen for any functional purpose, and was in fact more expensive to produce than the natural beige-yellow shade that press pads were ordinarily manufactured in.<sup>37</sup> One of the purposes that Qualitex offered for choosing such a unique color was to help consumers in the industry (dry-cleaning business owners) to quickly distinguish the press pads based on their appearance, which was particularly helpful in an industry in which products were ordered over the phone.<sup>38</sup> In 1989, despite the fact that Qualitex had been manufacturing their green-gold press pads continuously for the past thirty-two years, Jacobson Products, a Qualitex rival, began to copy the unique color on their respective press pads, while being forthright in their intention to duplicate the Qualitex press-pad.<sup>39</sup> By this point, the Qualitex Company had already expended over one million dollars in advertising and promotions (with the advertisements heavily highlighting the green-gold color), sold more than one million press pads, and, because of the company's long and exclusive use of the color mark, had acquired secondary meaning in the color sufficient to merit protection.<sup>40</sup> By copying the color of the Qualitex press-pad, Jacobson's products engendered actual confusion among purchasers. At trial, Qualitex presented consumer survey evidence illustrating that over 39 percent of survey respondents confused a Jacobson press pad with a Qualitex press pad, stating the color as their reason for confusion, while no respondents identified a green-gold press pad as a Jacobson product.<sup>41</sup>

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34. *Id.* (explaining the concept of shade confusion).

35. *Qualitex*, 514 U.S. at 168.

36. Brief for the United States Supporting Petitioner, *supra* note 24, at \*2.

37. *See id.* at \*16 (discussing how the green-gold color, chosen solely for ornamentation, did not aid in the performance of the press pad).

38. *See id.* at \*12 (describing that consumers in the dry cleaning and laundry industries often order products over the phone and distinguish them only by color).

39. *See* Brief in Opposition, *Qualitex*, 514 U.S. 159 (No. A-921 (93-1577)), 1994 WL 16012056, at \*2 [hereinafter Brief in Opposition].

40. *See* Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit, *Qualitex Co. v. Jacobson Prods. Co.*, 13 F.3d 1297 (9th Cir. 1994) (No. 93-1577), 1994 WL 16011921, at \*6 [hereinafter Petition for a Writ of Certiorari].

41. *Id.* at \*7-8.



Furthermore, Qualitex took the position that color marks were particularly necessary in the dry cleaning industry because of its large population of non-native English-speakers, who distinguished Qualitex products by their color, not their name.<sup>42</sup> Before trial began, Qualitex registered the green-gold color with the United States Patent and Trademark Office (USPTO) and added a trademark infringement count to its unfair competition claim in the suit.<sup>43</sup>

When the issue was taken up by the Supreme Court, the Court found that, because the Lanham Act was written in such broad terms, and included the terms “symbol” and “device” in the list of things that could be registered as trademarks, color was capable of being defined as an article that carried meaning.<sup>44</sup> Additionally, because the Lanham Act had been revised in 1988 and retained its original language concerning “symbols” and “devices,” the Supreme Court reasoned that, in light of the *Owens-Corning* decision, this definition had come to include color.<sup>45</sup> This terminology, in conjunction with the fact that items such as shapes, sounds, and smells could readily act as “symbols,” helped define color as an additional symbol or device that was protected under the Lanham Act.<sup>46</sup> The Court also found that color satisfied the most basic and fundamental requirement of a trademark: that it is used (or intended to be used) by a person to “identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of goods.”<sup>47</sup>

After establishing that color could fall under the definition of a trademark, the Court turned to the more important threshold question: whether a color could act as an indicator of source and thus acquire secondary meaning. The Supreme Court found that, over time, especially in an unusual context, customers might come to recognize the color of a product’s packaging—or even of the product itself—to signify a brand.<sup>48</sup> This finding effectively abolished the previous understanding of U.S. courts that color was incapable of acquiring distinctiveness, as well as Jacobson Products’ argument that precedent demonstrated that color marks were not protectable. Jacobson Products’ argument was further

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42. *See id.* at \*7.

43. *Qualitex*, 514 U.S. at 161; Brief for the United States Supporting Petitioner, *supra* note 24, at \*2 (noting that the green-gold color was obtained under Trademark Registration No. 1,633,711).

44. *See Qualitex*, 514 U.S. at 172–73.

45. Jonathan Hudis, *Removing the Boundaries of Color*, 86 TRADEMARK REP. 1, 3–5 (1996) (quoting *Qualitex*, 514 U.S. at 172–73).

46. *See Qualitex*, 514 U.S. at 162 (“If a shape, a sound, and a fragrance can act as symbols why, one might ask, can a color not do the same?”).

47. *Id.* (quoting 15 U.S.C. § 1127).

48. *See id.* at 162–63.

rejected because it myopically focused on cases decided before 1946, when the Lanham Act was passed.<sup>49</sup>

The Court also could not find a principled objection to color marks within the functionality doctrine,<sup>50</sup> despite its concerns that there existed a finite number of attractive colors.<sup>51</sup> By relying on its own language in *Inwood Laboratories Inc. v. Ives Laboratories, Inc.*, the Court held that a color was functional only if it was found to be “essential to the use or purpose of the article or if it affect[ed] the cost or quality of the article, that is, if exclusive use of the feature would put competitors at a significant non-reputation-related disadvantage.”<sup>52</sup> The third prong of the test was laid down to test for aesthetic functionality, which focused not on the utility of a product, but on its aesthetic appeal.<sup>53</sup> The Court found that, because color is not always essential to the performance of an article, and does not always affect the cost of the article, the doctrine of functionality does not necessarily apply a blanket prohibition on singular colors from gaining trademark protection.<sup>54</sup> The Supreme Court rejected Jacobson Products’ argument that competitors would always be put at a significant disadvantage by not being able to use particular colors and instead determined that the aesthetic functionality prong would act as a threshold test.<sup>55</sup> The Court supplemented its reasoning by acknowledging that hundreds of color pigments existed and thousands could be obtained from mixing.<sup>56</sup> The shade confusion argument was also found to be unpersuasive because courts are often faced with having to determine subtle differences in words and graphics, and would not have to commit substantially more effort to debate what shades were lawfully available for use.<sup>57</sup> On the issue of color depletion, the Court decided that, if a particular color was ever to deplete in an industry, the functionality doctrine would be able to effectively prevent anticompetitive consequences by forcing popular

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49. See *id.* at 170–73.

50. The functionality doctrine is used in trademark law to promote competition by preventing manufacturers from controlling useful and functional product features, and thus inhibiting legitimate competition. Historically, courts denying the protection of color marks have looked toward aesthetic functionality to support their reasoning that each color was by nature serving a function, which thereby made colors ineligible for trademark protection. See Parness, *supra* note 33, at 330, 383.

51. See Transcript of Oral Argument at 15, *Qualitex*, 514 U.S. 159 (No. 93-1577).

52. *Qualitex*, 514 U.S. at 165 (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982)).

53. Cf. *JANIS*, *supra* note 4, at 56–57.

54. See *Qualitex*, 514 U.S. at 165.

55. *Id.* at 168–69.

56. See *id.* at 168 (quoting LOUIS CHESKIN, *COLORS: WHAT THEY CAN DO FOR YOU* 47 (1947)).

57. See *id.* at 167–68.

colors to re-enter the public domain, which essentially rendered the Jacobson argument invalid.<sup>58</sup> This decision further bolstered the holding in *Owens-Corning* and established that color depletion was no longer a tenable threat to the promotion of fair use and competition.

On these findings, the Supreme Court ruled that color alone can act as a symbol to distinguish a firm's goods and identify its source.<sup>59</sup> By doing so, it affirmed the decision of the USPTO and supported the approval of a trademark registration for color per se, provided that no competitive need for that color to remain available existed in its industry, and the color was not functional.<sup>60</sup> From this point onwards, the United States began to provide uniform federal protection for colors marks,<sup>61</sup> and watched as the world began to follow suit.

## II. REACTIONS TO THE *QUALITEX* DECISION

When the *Qualitex* decision came down, the legal community fell into a panic that largely reflected the fears of the Ninth Circuit when it stated that the "better rule" was to not protect color. Commentators lamented the *Qualitex* decision, referring to it as an "aberration"<sup>62</sup> and as the "Qualitex Monster."<sup>63</sup> Critics argued that there was a limited color supply (despite extensive empirical evidence showing that the color spectrum is not limited to finite shades of red, orange, yellow,

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58. See *id.* at 169–70 (relying on the functionality holdings in *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 1532 (Fed. Cir. 1994) (finding that the color black could not be trademarked for a boat motor because it helped the motor match to many different boats, while making the motor look smaller in size); *Nor-Am Chem. Co. v. O. M. Scott & Sons Co.*, Civ. A. No. 86-3810, 1987 WL 13742, at \*4 (E.D. Pa. July 15, 1987) (finding that the color blue was functional for fertilizer because blue indicated the presence of nitrogen); *Deere & Co. v. Farmhand, Inc.*, 560 F. Supp. 85, 98 (S.D. Iowa 1982) (finding that the green color of John Deere tractors was functional because farmers preferred matching equipment), *aff'd*, 721 F.2d 253 (8th Cir. 1983)).

59. See *id.* at 166.

60. See *id.* The Supreme Court may have been influenced by Justice Breyer's trademark jurisprudence. There is some evidence that Justice Breyer may have recognized a strong administrative component in trademark law—accordingly, it is conceivable that his background in administrative law influenced him to grant great deference in the USPTO's decision to allow the registration of color marks, despite the well-established principled reasons that he usually offered against the extension of existing intellectual property laws. For a more in-depth discussion, please see Gordon R. Shea, Note, "Gathering His Beames with a Christall Glasse": *The Intellectual Property Jurisprudence of Stephen G. Breyer*, 2 MARQ. INTELL. PROP. L. REV. 195 (1998).

61. See TMEP § 1202.05 (5th ed. Sept. 2007).

62. See, e.g., Jonathan D. Baker, Note, *Correcting a Chromatic Aberration: Qualitex Co. v. Jacobson Products Co.*, 9 HARV. J.L. & TECH. 547 (1996).

63. See, e.g., Overcamp, *supra* note 14.

green, indigo, violet, and brown),<sup>64</sup> and many scholars feared that, by allowing such trademarks to gain protection, color depletion would quickly terrorize the consumer market in the form of manufacturer color monopolies.<sup>65</sup> Critics and scholars feared that, if corporations were allowed to monopolize color, it would restrict competition, create shade confusion in the market, and exclude new companies from particular industries. It was also argued that, by protecting color trademarks, courts would be flooded with litigation as manufacturers attempted to determine what shades were available to them, and heavily frustrate judicial efficiency.<sup>66</sup>

Proponents of the color depletion theory further argued that only particular shades were aesthetically appealing to consumer markets,<sup>67</sup> and thus the functionality doctrine would either dissolve into a meaningless provision (if courts chose to ignore this fact and grant protection to all the "pretty colors" on a first-come-first-serve basis), or would create a threshold so high that manufacturers would be barred from protecting singular color marks at all.<sup>68</sup> However, despite the fact that scholars continued to write on this subject until the beginning of the twenty-first century, as time progressed, each issue was resolved either by new innovations in the color industry or by subsequent rulings on the issue.

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64. See Brief of Private Label Manufacturers Association as Amicus Curiae in Support of Affirmance of the Decision Below, *Qualitex*, 514 U.S. 159 (No. 93-1577), at \*6 [hereinafter Brief in Support of Affirmance]; Jeffrey M. Samuels & Linda B. Samuels, *Color Trademarks: Shades of Confusion*, 83 TRADEMARK REP. 554, 555 (1993); Jean Hayes Kearns, Comment, *Qualitex Co. v. Jacobson Products Co.: Orange You Sorry the Supreme Court Protected Color?*, 70 ST. JOHN'S L. REV. 337, 343-44 (1996).

65. See, e.g., Kearns, *supra* note 64, at 353-55; Overcamp, *supra* note 14, at 598-99; see also Brief in Support of Affirmance, *supra* note 64.

66. See, e.g., *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1131 (Fed. Cir. 1985) (Bissell, J., dissenting); Overcamp, *supra* note 14, at 613.

67. See, e.g., Baker, *supra* note 62, at 559; Overcamp, *supra* note 14, at 616-17.

68. See Kearns, *supra* note 64, at 355-57 (noting that if courts must examine "actual and potential" needs of the industry, the functionality doctrine can only operate effectively by banning color trademarks in virtually every market, since courts do not have the "clairvoyance necessary to accurately predict the likelihood of future competitors in a particular market"); see also Brief in Support of Affirmance, *supra* note 64, at 11-12 (stating that particular industries indicate the function of their product by color, giving examples such as distinguishing fire extinguishers by the color red, ice cream and frozen products by colors blue and silver, and antifreeze by the color yellow).

### III. THE CONCERNS OF THE LEGAL COMMUNITY PROVED UNFOUNDED IN LOCAL MARKETS

#### *A. Developments in the Color Industry Have Helped Alleviate Issues Surrounding the Registration of Colors and the Threat of Color Depletion*

In the twenty years since *Qualitex* was decided, advances in technology have helped alleviate the fears scholars initially had over protecting color marks. Many writers lamented that the finite number of colors in our world would prohibit competition by barring newcomers from entering particular markets. However, this argument was largely based on an antiquated understanding of pigment technology, and only demonstrates that trademark law has spent a considerable amount of time catching up to color technology in the twentieth century.<sup>69</sup> Furthermore, the trademark application process has been simplified due to the mainstream use of color referral systems.

Many members of the legal community were skeptical over how the actual registration of a particular color would take place. However, the development and expansion of several internationally recognized color identification systems, such as Pantone and the RAL color system, have helped resolve the issue of how to apply for the registration of a particular color with the USPTO. The USPTO requires that when registering any trademark, a clear drawing be provided with the application,<sup>70</sup> along with a description in words.<sup>71</sup> Critics theorized after *Owens-Corning* that this component of the trademark application would result in grave shade confusion when applying for a color registration because of the limited way to describe colors.<sup>72</sup> However, due to the spreading use of color identification systems, a trademark applicant can now describe his or her color by referring to a Pantone or RAL code. Furthermore, as of 2003, trademark registration forms are no longer printed or published in black and white, and the USPTO will not accept black-and-white applications or applications that use the USPTO's now-

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69. Books were published as early as the late 1940s outlining the vast number of shades that were becoming available to mainstream manufacturers, and how they could be manipulated to create effective advertising. See generally CHESKIN, *supra* note 56 (discussing the use of colors in various contexts, including marketing).

70. TMEP § 807 (5th ed. Sept. 2007).

71. *Id.* § 808.01.

72. See *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 1131 (Fed. Cir. 1985) (Bissell, J., dissenting) (arguing that by allowing an application, which merely described the trademark as "pink," to be registered, competitors conducting a clearance search would not have an adequate understanding of what shades were available to them, particularly due to the limitations of the registration system).

defunct color lining system, which only referred to twelve colors.<sup>73</sup> These modifications to the application and registration process have helped effectively communicate which particular shades are eligible for trademark protection in the United States.

Additionally, technology has advanced to create thousands of different synthetic pigments and dyes for contemporary products.<sup>74</sup> Colors can be manipulated by creating new base red-green-blue (RGB) compositions and adjusting for hue, saturation, and brightness.<sup>75</sup> This innovation has led to an infinite variety of color choices and now offers hundreds of new possibilities in creating distinct brand images based on stimulating and aesthetically pleasing colors. By contrast, in 1995 legal scholars determined that it was inconceivable for a color to be inherently distinctive because every color was thought to have always existed in the world. Since then, however, by capturing the ability to manipulate the hue, lustre, and base tones of a color, computers are now generating new and synthetic tones. This has led to several companies creating one-of-a-kind and unique colors, which are fully protected as private shades by the color associations contracted to create them.<sup>76</sup> For example, Tiffany & Co. commissioned Pantone to create a robin's egg blue that would be unique and exclusive to the Tiffany's brand. This color is now protected by the USPTO as Pantone 1837, "Tiffany Blue."<sup>77</sup>

The popularity and aesthetic status of colors is now heavily influenced by biannual industry color reports, which directly diminish the prospect of "running out of aesthetically pleasing colors," as the Ninth Circuit predicted in 1994. The creation of these reports is deliberately shrouded in mystery—all that is known is that twice a year, trend forecasters, industry insiders, and national representatives gather at associations such as Pantone and the Color Association of America to present theses in closed-room meetings on the current color trends pervading each industry. The industries that are consulted range from

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73. Gilson & Gilson LaLonde, *supra* note 13, at 778–79, 794.

74. See DAP Prods., Inc. v. Color Tile Mfg., 821 F. Supp. 488, 495 (S.D. Ohio 1993).

75. See, e.g., *Create*, ADOBE COLOR CC, <https://color.adobe.com/create/color-wheel/> (last visited Nov. 14, 2015) (computer software that allows users to create and explore computer-generated colors); Creative Market Labs, Inc., *COPASO: Color Palette Software*, COLOURLOVERS.COM, <http://www.colourlovers.com/copaso/ColorPaletteSoftware> (last visited Nov. 14, 2015) (an advanced color tool program that allows its users to generate unique color palettes).

76. At the time that *Qualitex* was decided, the Court did not fully realize the potential to create unique and nonnatural colors through computer programming. However, despite the fact that computer-generated colors can be intrinsically distinctive in nature, the current interpretations and understanding of the *Qualitex* decision make it impossible for colors to gain trademark protection under the "inherently distinctive" prong.

77. Registration No. 2,359,351. 1837, the Pantone color code for Tiffany Blue pays homage to the company's founding year.

travel to cosmetics to automobiles.<sup>78</sup> The theories presented help to predict and forecast the twenty-four colors that will become popular in two years' time,<sup>79</sup> and are heavily influenced by cultural trends, current events, and public mood.<sup>80</sup>

Because these predictions are based largely upon interpretations of the world around us, colors that would not normally be viewed as "pretty" or "popular" are thrust into the mainstream market.<sup>81</sup> For example, when the United States experienced a large influx of Hispanic immigrants in 2001, trend forecasters celebrated by gravitating toward deep and fiery reds.<sup>82</sup> When the state of the planet's oceans came to the forefront of the public's mind, palettes transitioned to cool and somber blues.<sup>83</sup> Additionally, unforeseeable events can change the trajectory of color trends. For instance, after the events of September 11, 2001, the U.S. public began to gravitate sharply toward more natural and heritage-inspired colors,<sup>84</sup> which departed markedly from the striking, vivid reds that color boards had forecast due to the new Hispanic influence in the country.

The designated colors are then published in a trend forecast book (starting at \$750 per issue)<sup>85</sup> that is purchased for guidance by different designers and manufacturers.<sup>86</sup> However, while it is considered a

78. See *Living Style: Color Forecasting: Making Friends with Color Trends*, SHERWIN-WILLIAMS, <http://www.sherwin-williams.com/architects-specifiers-designers/inspiration/color-conversation/living-style/sw-article-pro-lscolorforecast.html> (last visited Nov. 14, 2015).

79. See SHEENA IYENGAR, *THE ART OF CHOOSING* 144–45 (2010) (discussing how the color forecasts are used in various industries, such as fashion, interior design, website design and signature looks).

80. See, e.g., *id.* at 145–47 (discussing how designers, retailers, and new businesses purchase trend forecasts to receive consultation on how to create consumer appeal in new logs and up-and-coming products according to future trends); William L. Hamilton, *Seeing the Future in All Its Hues*, N.Y. TIMES, Jan. 10, 2002, at F1 (listing Nike, Shiseido, Apple, DKNY, and Martha Stewart Living as some of Pantone's largest clients).

81. For an illustrative example, please refer to the *Pantone Fashion Color Report Spring 2015*, PANTONE (last visited Nov. 14, 2015), <http://www.pantone.com/pages/fcr/?season=spring&year=2015&pid=11> (listing Pantone 18-0538 "Woodbine" as one of the hottest trends of the year due to its status as a "classic yellow-green" with an ability to be "used with anything and everything"—despite the fact that it largely resembles something you may find splattered across your car after leaving it under a tree full of birds).

82. See Hamilton, *supra* note 80.

83. See *id.*

84. See *id.*

85. See Tom Vanderbilt, *Sneaking into Pantone HQ: How Color Forecasters Really Decide Which Hue Will Be the New Black*, SLATE, (Apr. 27, 2012, 6:33 AM) [http://www.slate.com/articles/arts/design/2012/04/pantone\\_color\\_forecasts\\_are\\_they\\_accurate\\_.html](http://www.slate.com/articles/arts/design/2012/04/pantone_color_forecasts_are_they_accurate_.html).

86. See, e.g., *Trend Forecasting*, PANTONE, <http://www.pantone.com/pages/pantone/>

market norm to subscribe to color forecast services, following the recommendations by-the-book is considered among designers as “market suicide.”<sup>87</sup> The danger in taking color forecasts too literally is that it becomes impossible to gain distinctiveness in a brand. To counteract mainstream trends, companies will consult multiple color forecasts and collaborate with local vendors to establish a point of divergence from their competitors.<sup>88</sup> Designers will also purchase color forecasts for the express purpose of *deviating* from the current trends.<sup>89</sup> Instead, designers will choose to pull their inspirations from the street, which results in what the fashion industry calls the “trickle-up” effect—where the public dictates through their own use what is popular. In fact, Alexander McQueen was once inspired by a shirt he observed the character of Joey Tribbiani wearing on an old episode of the ’90s sitcom *Friends*.<sup>90</sup> Additionally, the more disposable an item, the more willing the manufacturers and public will be to experiment with color. The current obsession with instant gratification and the public’s fascination with fast, disposable fashion is thus creating hypertrends, which directly influence shorter lifespans for colors in the mainstream market and create a smaller likelihood that colors will be infringed on.

Because color forecasts directly set many points of departure within the design industry, the wide range of shades that manufacturers gravitate toward (and thus, what consumers gravitate toward), is preventing color depletion in local markets. However, while color forecasts are not inducing color depletion, they are exposing the aesthetic functionality doctrine as inchoate. In the context of color marks, the aesthetic functionality doctrine operates to prevent useful and necessary colors from being monopolized by manufacturers. Yet the law as it is currently constructed does not acknowledge the temporal dimension of color popularity, and thus does not properly protect free competition in markets influenced by hypertrends and color cycles. For example, if the Pantone Color Report decides that Pantone 1375 UP<sup>91</sup> should experience a resurgence in the design industry, home products such as golf umbrellas or ice buckets may cause confusion with Veuve Clicquot’s orange mark (Pantone 137C),<sup>92</sup> which is applied to goods used

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category.aspx?ca=90 (last visited on Nov. 14, 2015); *see also* IYENGAR, *supra* note 79.

87. *See* Hamilton, *supra* note 80.

88. *See id.*

89. *See, e.g.*, IYENGAR, *supra* note 79, at 147 (describing Calvin Klein’s purchase of color forecasts, specifically “so he’ll know what *not* to do”).

90. *See In Awe of Sarah Burton*, LANE CRAWFORD (Nov. 1, 2011, 9:02 PM), <http://www.lanecrawford.com/landing/featureArticle.jsp?article=4400030>.

91. *Pantone 1375 UP*, PANTONE, [http://www.pantone.com/pages/pantone/colorfinder.aspx?c\\_id=1023](http://www.pantone.com/pages/pantone/colorfinder.aspx?c_id=1023) (last visited Nov. 14, 2015).

92. *Pantone 137 C*, PANTONE, <http://www.pantone.com/pages/pantone/colorfinder>.



during the champagne label's sponsored outdoor events. To remedy this potential conflict in trademarks, in the context of design, policymakers must take action to limit the aesthetic functionality test to act compatibly with the lifespan of a color trend. This can be achieved by having courts refer to current color forecasts in cases regarding shade confusion—by understanding the particular lifespan of a color, courts will not have to overextend the aesthetic functionality doctrine (by misinterpreting a currently popular color as a universally popular color) to prevent market competitors from enjoying and participating in current fashion trends. Courts may also require companies that wish to co-opt fashionable colors to add clear word marks or logos to their products to mitigate any further brand confusion. On this trajectory of reasoning, color marks can continue to transcend trends as ultimate source indicators of a product, while still allowing competitors to use particular shades by keeping such use limited to designated short periods of time. Additionally, if the issue is merely limited to particular colors flooding the market at different times, the secondary meaning requirement and the market desire for distinctiveness will help prevent companies from monopolizing those colors when they are in vogue.

*B. Subsequent Interpretations of the "Secondary Meaning" Requirement Have Assisted In Raising the Threshold For Acquiring Distinctiveness in a Mark*

Since 1995, courts and the USPTO have effectively safeguarded the right to use singular color marks by relying heavily on the secondary meaning requirement and the functionality doctrine. In determining subsequent cases, courts have followed the approach taken in *Owens-Corning* and *Qualitex* by examining issues of advertising expenditures, years of exclusive use, and the color mark's effect on competition in that particular industry.

Although intellectual property scholars initially speculated to what extent the functionality doctrine and secondary meaning requirement would weigh in a court's analysis, by 1999, the roadmap for deciding color trademark issues had become quite clear. In the wake of the *Qualitex* decision, the USPTO began to apply a three-step analysis to determine the registrability of a color mark: 1) Was the color functional? 2) Would taking the color out of the public domain frustrate fair

competition? 3) Is the color distinct enough to act as an indicator of its source?<sup>93</sup>

Functionality was never highly debated in subsequent courts' analyses. The analysis of a functional color was straightforward and outlined clearly in cases such as *Qualitex*, *Owens-Corning*, and *Nor-Am Chemical Company*,<sup>94</sup> where using a color "that in context seems unusual" (and not necessary to the productivity of the article) would help pass the functionality test.<sup>95</sup> The doctrine was also further expanded in subsequent cases and came to be understood as the "necessary-for-effective-competition test," where "a mark is functional if 'exclusive use of the feature would put competitors at a *significant* non-reputation-related disadvantage'."<sup>96</sup> However, courts began to struggle with the secondary meaning requirement, partly because the Supreme Court did not provide guidelines or an in-depth analysis when deciding the *Qualitex* case.<sup>97</sup> Courts instead began to follow the holistic approach taken in both *Qualitex* and *Owens-Corning*, and examined direct and circumstantial evidence to determine if a mark had legitimately acquired a secondary meaning in its market.

In determining whether consumers recognize a color mark as distinctive in an industry, courts will accept customer testimonies and survey results as direct evidence.<sup>98</sup> Customer testimony can be provided

93. See James L. Vana, *Color Trademarks*, 7 TEX. INTELL. PROP. L.J. 387, 394-95 (1999).

94. In *Nor-Am Chemical Co. v. O.M. Scott & Sons Co.*, the Nor-Am Chemical Company sought to enjoin O.M. Scott & Sons from selling a similarly blue-colored fertilizer in a specialty agricultural fertilizer market. *Nor-Am Chem. Co. v. O.M. Scott & Sons Co.*, Civ. A. No. 86-3810, 1987 WL 13742, at \*1 (E.D. Pa. July 15, 1987). However, because the court found evidence showing that the scientific community used the color blue to designate the existence of nitrogen in a product, and because the color blue "commonly identifies nitrogen in fertilizers outside the specialty agricultural fertilizer market," the color could not be protected. *Id.* at \*4.

95. *Qualitex*, 514 U.S. at 163; accord *In re Owens-Corning*, 774 F.2d 1116, 1122 (Fed. Cir. 1985) (discussing pink, with regard to insulation, as non-functional); *Nor-Am Chem. Co.*, 1982 WL 13742, at \*4 (discussing the necessity in the fertilizer market of the color blue). Note, however, that the *Qualitex* court in dicta suggests that an unexpected or unnecessary color will still be viewed favorably. See *Qualitex*, 514 U.S. at 163.

96. Emilie Winckel, Note, *Hardly a Black-and-White Matter: Analyzing the Validity and Protection of Single-Color Trademarks Within the Fashion Industry*, 66 VAND. L. REV. 1015, 1044 (2013) (quoting *Qualitex*, 514 U.S. at 165).

97. See, e.g., Vana, *supra* note 93, at 393-94 (stating that the secondary meaning question was not resolved by *Qualitex*).

98. See *id.* at 398-99; cf. *T-Mobile US, Inc. v. AIO Wireless LLC*, 991 F. Supp. 2d 888, 906-08 (S.D. Tex. 2014) (using consumer survey data as direct evidence of secondary meaning for T-Mobile's magenta color); *RE/MAX Int'l, Inc. v. Trendsetter Realty, LLC*, 655 F. Supp. 2d 679, 700 (S.D. Tex. 2009) (considering survey evidence that customers associated the red-white-and-blue tri-color mark with RE/MAX).

in the form of letters, and are found to be especially persuasive if submitted by professional customers.<sup>99</sup> Testimony can also be submitted by professional buyers and through unsolicited consumer calls in which the purchaser refers to the product by its color.<sup>100</sup> Courts also find survey evidence extremely persuasive<sup>101</sup>—the Qualitex Company demonstrated that over 39 percent of individuals surveyed recognized a green-gold dry cleaning pad as a Qualitex pad,<sup>102</sup> while Christian Louboutin showed that almost all of his consumers, who misidentified a monochromatic red-soled YSL shoe as a Louboutin shoe, offered the color of the sole as their determining factor.<sup>103</sup>

Courts will usually then proceed by weighing circumstantial evidence to demonstrate secondary meaning. Evidence can include the duration that a color mark has been in continuous use by its owner,<sup>104</sup> advertising expenditures,<sup>105</sup> the focus of the advertising,<sup>106</sup> and its public platform.<sup>107</sup> For example, in *T-Mobile v. AIO Wireless*, the court determined that, because T-Mobile had been using its magenta mark (often referred to as “plum”) in U.S. commerce for over ten years, and because its advertisements had been consistently dominated by large swathes of magenta, the color (as well as a particular spectrum of

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99. See, e.g., Vana, *supra* note 93, at 398; see also Petition for a Writ of Certiorari, *supra* note 40, at 7–8 (where testimonials by dry cleaner owners recognizing a green-gold dry cleaning pad as a Qualitex product was found to be especially persuasive in demonstrating secondary meaning).

100. See Vana, *supra* note 93, at 398–99 (discussing the consideration by the Trademark and Trial Board of purchasing managers testimony on color-product association and of logs of unsolicited consumer calls who identified certain products as created by the applicant).

101. *Id.* at 399.

102. Petition for a Writ of Certiorari, *supra* note 40, at 7.

103. See *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 228 (2d Cir. 2012).

104. See 15 U.S.C. § 1052(f) (2012) (establishing that a prima facie showing of distinctiveness can be established through proof of substantially exclusive and continuous use of a mark for five years); *Louboutin*, 696 F.3d at 226 (discussing how Louboutin had been selling red lacquered shoes in the fashion industry for over twenty years).

105. See *In re Owens-Corning*, 744 F.2d 1116, 1127 (Fed. Cir. 1985) (demonstrating that Owens-Corning had spent over \$42 million in advertising, and thus had sufficiently exposed the public to the pink mark to establish an association with its brand); *T-Mobile US, Inc. v. AIO Wireless LLC*, 991 F. Supp. 2d 888, 905-06 (S.D. Tex. 2014) (demonstrating that, by pouring millions of dollars into advertising, T-Mobile had sold over \$130 billion worth of goods in the United States).

106. See *T-Mobile*, 991 F. Supp. 2d at 905 (considering T-Mobile’s prominent use of magenta in nearly every advertisement as evidence weighing toward a finding of secondary meaning).

107. See *T-Mobile*, 991 F. Supp. 2d at 906 (considering T-Mobile advertisements in newspapers, television, and other media as weighing toward a finding of secondary meaning for magenta); Vana, *supra* note 93, at 401–02.

purple) had acquired a secondary meaning in the U.S. consumer market.<sup>108</sup> The court also took several other factors into consideration: AIO Wireless was created specifically by AT&T to compete with T-Mobile in the “un-carrier” industry;<sup>109</sup> the subsidiary used plum to distinguish its stores, website, and coverage map (creating shade confusion), instead of its parent company’s signature orange (a practice considered the industry norm in the cellular communications market).<sup>110</sup> Similarly, in *Louboutin v. YSL*, the court found that, because Christian Louboutin had been applying a lacquered red to the soles of his shoes for over twenty years, the color had gained secondary meaning in the fashion industry, as well as in the mainstream consumer market.<sup>111</sup> Therefore, subsequent interpretations of the secondary meaning requirement helped establish a threshold high enough to prevent color depletion, while still fostering fair competition in various industries.

#### IV. THE RISE IN GLOBAL TRADE AND THE INTERNATIONAL EFFORT TO HARMONIZE TRADEMARK LAWS MAY CREATE NEW HURDLES FOR GLOBALLY EXPANDING COMPANIES ATTEMPTING TO PROTECT COLOR MARKS IN FOREIGN JURISDICTIONS

In 1997, international consumer agencies accepted 136 global or multinational branding assignments.<sup>112</sup> This can be directly attributed to mainstream use of the Internet: the burgeoning use of online marketplaces and communication forums directly influenced a rise in the global consumer. Since the 1990s, the number of multinational brands has grown exponentially and expanded trade across the globe. Many countries have thus begun to harmonize trademark laws with those of the United States (based on the *Qualitex* decision) to protect

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108. See *T-Mobile*, 991 F. Supp. 2d at 905–06.

109. *Id.* at 899, 901; see also Matt Hickey, *T-Mobile Sues AT&T Over Subsidiary’s Use of the Color Purple, Or Magenta, Or Whatever*, FORBES (Aug. 28, 2013, 7:44 PM), <http://www.forbes.com/sites/matthickey/2013/08/28/t-mobile-sues-att-over-subsidiarys-use-of-the-color-purple-or-magenta-or-whatever/>.

110. See *T-Mobile*, 991 F. Supp. 2d at 918–19, 926; see also Hickey, *supra* note 109 (finding that although the “plum” shade used by AIO Wireless was not “magenta” per se, the shades were close enough to cause confusion, which indicated AIO’s intention to imitate T-Mobile’s brand).

111. See *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holdings, Inc.*, 696 F.3d 206, 226–28 (2d Cir. 2012) (stating that when the red sole contrasts with its “upper” counterpart, the color gained secondary meaning).

112. Ming. H. Hsieh, *Identifying Brand Image Dimensionality and Measuring the Degree of Brand Globalization: A Cross-National Study*, 10 J. INT’L MARKETING 46, 46 (2002).

incoming foreign suppliers and foster trade and competition. For example, in 2003, in the landmark case *Libertel Groep v. Benelux*, the European Court of Justice (ECJ) reinterpreted its trademark laws to determine that color per se could be protected in all twenty-eight of its member states.<sup>113</sup> In May 2014, Japan (via the Ministry of Economy, Trade and Industry) revised its trademark legislation to include protection for color per se. This was done specifically to promote trade and Japan's reputation as the foremost "IP Building Nation" over the next decade.<sup>114</sup> Due to the recent revisions and interpretations of trademark laws in Japan and in the EU, Canada began to take significant steps in 2014 toward the implementation of the Madrid Protocol.<sup>115</sup> This implementation is expected to officially harmonize Canada with the rest of the developed world and codify the right to trademark colors, without restricting the color mark to the confines of a particular design or shape.<sup>116</sup>

Online marketplaces (such as Alibaba, Amazon, ASOS, Etsy, and personal websites) are now making it possible for small-scale manufacturers to participate in international trade to greater extents. The saturation of goods in online and international trade has yielded both positive and negative results. While it is now possible for immigrants and travelers to acquire their favorite hometown goods in

113. See Case C-104/01, *Libertel Groep BV v. Benelux-Merkenbureau*, 2003 E.C.R. I-03793 (para. 37, ruling 1) (stating that the applicant need only demonstrate that the color is capable of graphic representation and has acquired distinctiveness in its market, and finding that an internationally recognized color code was acceptable as a graphic representation because it met the requirements of precision, uniformity, and stability).

114. James D. Hughes, *Japan: Trademark Law Amendments Allow for Color and Sound Marks*, INT'L TRADEMARK ASS'N (July 15, 2014), <http://www.inta.org/INTABulletin/Pages/JAPANTrademarkLawAmendmentsAllowforColorandSoundMarks.aspx>; see also Emi Aoshima, *Revision of the Japanese Trademark Act and Design Act in 2014*, YUASA & HARA INTELL. PROP. NEWS 1 (June 2014), <http://www.yuasa-hara.co.jp/english/wp-content/uploads/sites/2/2014/01/ipnews040.pdf>.

115. See Peter Giddens, *Changes to Canada's Trademark Law Explained*, INT'L TRADEMARK ASS'N (July 15, 2014), <http://www.inta.org/INTABulletin/Pages/ChangestoCanadasTrademarkLawExplained.aspx>.

116. However, it should be noted that Canada has reinterpreted its existing trademark laws to harmonize with the North American Free Trade Agreement. Canadian laws allow trademark protection of singular colors, only requiring that the color is confined to a specific design or shape. Although a straight reading of this rule may cause one to think that color marks per se are therefore barred in Canada, the law is congruous when applied to the actual product or packaging (e.g., the green-gold Qualitex color was limited to dry-cleaning press pads, and was not featured on its packaging; Louboutin red is confined to the sole of the shoe). The law is also harmonious with the reinterpretation of EU trademark law, which states colors cannot be registered for protection "in every conceivable form." Case C-49/02, *Heidelberger Bauchemie GmbH*, 2004 E.C.R. I-6129 (para. 34).

foreign countries—thus fostering productive competition in the global economy—the importation of foreign goods will inevitably begin to cause confusion in the marketplace, something trademark law is specifically designed to prevent.

For example, in 2000, a conflict arose between BP Oil and John Kelly, a local gas station owner in Northern Ireland, when Kelly began to adorn his service stations with the color green.<sup>117</sup> However, BP had already obtained a trademark on Pantone 348C (grass green) when applied to gas stations and oil services—specifically because it was determined by marketing consultants that the company's signature green was the most effective marketing tool in its possession.<sup>118</sup> The Court of Appeals in Ireland found that, because of the shade confusion caused by Kelly's green service stations, and the significant market investments made by BP, the company had gained widespread brand recognition based on its color in the United Kingdom.<sup>119</sup> The Court upheld BP's right to use Pantone 348C exclusively.<sup>120</sup> This ruling created a direct conflict with a recent decision in Australia: in 2014, BP failed to obtain trademark protection for Pantone 348C under Australian trademark law. The government agency found that BP was not able to show convincing evidence that the color green was intrinsically linked to consumers' minds when searching for gas, specifically due to the Woolworth's brand (a domestic Australian brand) and its well-established use of the color green on service stations.<sup>121</sup> The inability of BP to fully protect its brand across all jurisdictions is illustrative of the discord that the secondary meaning requirement (known as "acquired distinctiveness" in the EU) creates in global trademark protection, as well as the disadvantage of the inherently territorial nature of trademark law. Therefore, despite recent global attempts to harmonize trademark laws, uniformity is not being

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117. BP Amoco PLC v. John Kelly Ltd., [2001] NICA (Civ) 3, [1]; [2001] N.I. 25, available at <http://www.bailii.org/nie/cases/NICA/2001/3.html>.

118. *Id.* at [6], [18]-[19], [47] (summarizing the survey findings of BP's marketing consultants that consumers, while on the road, specifically associated the color green with BP service stations).

119. See *id.* at [62], [64]; Gordon Humphreys, *A Selective Review of Colour Mark Issues and Case Law in the EU*, FORDHAM IP CONF. 16 (Mar. 11, 2013), [http://fordhamipconference.com/wp-content/uploads/2013/03/2013.humphries.design.paper\\_.pdf](http://fordhamipconference.com/wp-content/uploads/2013/03/2013.humphries.design.paper_.pdf).

120. Humphreys, *supra* note 119.

121. See Michael Safi, *BP Loses Battle to Trademark the Colour Green in Australia*, THE GUARDIAN, (July 3, 2014, 3:14 AM), <http://www.theguardian.com/business/2014/jul/03/bp-loses-battle-to-trademark-the-colour-green-in-australia>; Yolanda Redrup & Patrick Durkin, *Not Easy Being Green: BP Loses Bid to Trademark Colour*, SYDNEY MORNING HERALD, (July 3, 2014), <http://www.smh.com.au/business/not-easy-being-green-bp-loses-bid-to-trademark-colour-20140702-zsu3i.html>.

achieved in the outcome of legal disputes. Furthermore, if behemoth brands cannot acquire distinctiveness in foreign markets—even after participating in the market for many years—the future is grim for small-scale newcomers looking to expand into new jurisdictions.

Another significant issue that has begun to pervade international courts is color depletion in global brands. After *BP v. Kelly*, it is clear that BP owns the rights to grass green when applied to petroleum service stations, and that the company will continue to tenaciously protect its brand against competitors in the European and American petroleum industry. Deutsche Telekom (the parent company of T-Mobile) has also fiercely protected its right to the color magenta in the cellular communications industry, as illustrated in *T-Mobile v. AIO Wireless*. This case in particular is extremely troublesome because Deutsche Telekom has acquired secondary meaning in many countries across the globe (including the United States and all EU member states), and because of its vast monopoly over the “plum” spectrum. It is clear that by allowing international brands to protect their color marks across many jurisdictions, color depletion is beginning to materialize in global markets. Furthermore, applying the functionality doctrine in instances in which color depletion becomes a tenable threat will no longer be a viable option in rapidly globalizing industries—the outcome will inevitably render colors ineligible for trademark protection and catalyze confusion and dilution internationally.

It is clear that amending U.S. trademark laws will not achieve an adequate resolution for international color depletion. Although color depletion will not manifest in global markets for at least several years, the sheer scale of such an impending problem calls specifically for an international effort. This Note puts forth the recommendation that the United States request an international organization (such as the World Intellectual Property Organization (WIPO)) to study and draft a proposal that will help combat international color depletion when it occurs in transboundary trade. Ultimately, however, it is inevitable that a level of discord will have to continue between nation-states due to the territorial nature of trademark law and the differences in recognition that each brand enjoys in various jurisdictions.

*A. International Requirements for Acquired Distinctiveness Hinder the Ability of Newcomers and Small-Scale Businesses to Enter Foreign Markets*

Twenty years after *Qualitex*, it has become well-established jurisprudence that industry newcomers must satisfy several requirements before receiving trademark protection for their color

marks in the United States and abroad: continuous use of the color in the market; significant advertising expenditures specifically devoted to creating brand recognition in the color mark; marketing specifically aimed at the manufacturer's customer base; and the product's sales volume. However, market entrants and small-scale businesses are operating at a disadvantage in foreign trade for several reasons.

First, EU trademark laws have raised the threshold for industry newcomers by requiring that a color mark demonstrate acquired distinctiveness in *all twenty-eight member states* before becoming eligible for a Community Trade Mark (CTM).<sup>122</sup> However, unlike the U.S., the cultures, languages, and people vary vastly across the Union, making it much more difficult to achieve acquired distinctiveness across the whole EU. Although companies will always have a choice to limit trademark registration and protection to particular member states, the cost of multiple registrations, and possibly multiple proceedings, can put companies with limited assets at a significant disadvantage.

Second, because international systems and trade agreements have not implemented the requirement that applicants cite to an international color identification system, the ability to conclusively research which colors a newcomer may lawfully use is frustrated.<sup>123</sup>

Third, although trademark law states that factors such as continuous use in a market and advertising expenditures are not sufficient to prove secondary meaning without influencing the consumer's perception of the mark, courts often overemphasize product sales volume and advertising investments and expect large numbers and expenditures to illustrate that secondary meaning in a mark exists. Without it, it is almost impossible to establish that a company has a definite place in the market, despite the recognition a mark may enjoy within its niche consumer base.

Lastly, if already-established companies wish to expand into foreign markets, there is a chance that the company will have to rebrand its color mark to be able to compete in jurisdictions in which their color signature has already been trademarked. Rebranding is an expensive endeavor. Even corporations with deep pockets are put at a significant financial disadvantage when they choose to rebrand.<sup>124</sup> However, while

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122. See Humphreys, *supra* note 119, at 10, 12.

123. See World Intell. Prop. Org. [WIPO], *Making the Most of the Madrid System: Information and Practical Tips on How to Use Specific Forms*, at 15 (2014), available at [http://www.wipo.int/export/sites/www/madrid/en/forms/docs/making\\_the\\_most\\_of\\_the\\_madrid\\_system\\_mm\\_forms.pdf](http://www.wipo.int/export/sites/www/madrid/en/forms/docs/making_the_most_of_the_madrid_system_mm_forms.pdf) (emphasizing that the Madrid System only *recommends* that the applicant provide a Pantone or RGB code in the description box of the application).

124. See Saleh Abdulaziz AlShebil, *Consumer Perceptions of Rebranding: The Case of Logo Changes 2* (Aug. 2007) (Ph.D. dissertation, the University of Texas at Arlington) (available through Proquest Dissertations Publishing).



conglomerate corporations can easily bounce back from significant expenditures, small-scale businesses do not often operate with that privilege.<sup>125</sup> Furthermore, conglomerate companies frequently use their deep pockets to create David-and-Goliath-esque cases in which they can coerce their competitors to rebrand, confine themselves to a limited geographical territory, or even withdraw from particular markets. This directly puts small businesses and industry newcomers at a measurable competitive disadvantage when entering international trade, and may restrict their access to foreign markets altogether.<sup>126</sup>

This Note makes several recommendations to help foster free competition in international markets: 1) It would be prudent for the Committee of Experts of the Vienna Union to revise the next edition of the Vienna Classification System for the Figurative Elements of Marks to include an official color code in the trademark categorization and application process. 2) Courts should revise their approach in determining if secondary meaning has been met by refraining from overemphasizing advertising expenditures and product sales volume in cases that are based predominantly on e-commerce sales in niche markets. 3) Instead, countries should give more deference to consumer surveys conducted on e-commerce platforms to properly understand the brand's recognition in relevant customer bases.

This Note calls for a revision of Section 29 of the Vienna Classification System, which classifies color marks.<sup>127</sup> The Vienna Agreement, a special agreement under the Paris Union, provides a classification system for the figurative elements of marks (including images, geometric figures, and colors) for the purpose of facilitating trademark anticipation searches and obviating substantial reclassification work for documents being exchanged on international platforms.<sup>128</sup> By requiring applicants to supplement their trademark

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125. For example, registering or protecting a color mark in the European Union can cost more than \$150,000, before taking into account that the Office for Harmonization in the Internal Market (OHIM) is often reluctant to rule on color marks, and will most likely request the Court of Appeals to make a decision. In contrast, protecting a word mark in the Union will only cost about \$2,000.

126. Cf. Labadie-Jackson, *supra* note 27, at 108 (discussing the potential for a competitive market advantage by established businesses who trademark colors and deplete the supply available for newcomers).

127. The Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks entered into force in 1973. *Summary of the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks (1973)*, WIPO, [http://www.wipo.int/treaties/en/classification/vienna/summary\\_vienna.html](http://www.wipo.int/treaties/en/classification/vienna/summary_vienna.html) (last visited Nov. 15, 2015).

128. World Intell. Prop. Org. [WIPO], *International Classification of the Figurative Elements of Marks (Vienna Classification)*, at v, WIPO Publ'n No. 502E/7 (7th ed. 2012), available at <http://www.wipo.int/classifications/nivilo/pdf/eng/vienna/vie7eng.pdf>.

registrations with a color code, the Madrid System and the Vienna Classification System will be able to aid in properly informing industry newcomers of the colors that are lawfully available to them. Additionally, a revision of the Vienna Classification System would be the most efficient way to incorporate official color designations on a global scale due to its widespread use as an international trademark classification system: the Vienna Classification System is applied by approximately sixty trademark offices worldwide<sup>129</sup> and is used by several major regional organizations and bureaus, including the Office for Harmonization in the Internal Market (OHIM) and WIPO, which applies a modified version of the Vienna Classification through the framework of the Madrid System (the OHIM Vienna Classification Manual) for the international registration of marks.<sup>130</sup> Additionally, if the Madrid System can identify what particular range in the color spectrum constitutes shade confusion (for example, through a rule preempting the use of shades within five color codes of a registered mark), courts will not have to make subjective or irregular conclusions as to what constitutes shade confusion and trademark owners can expect uniformity in future decisions. Creating an international register of color marks is especially important due to the geographic limitations of trademarks, which can result in color marks being heavily protected in some jurisdictions, while being denied protection in others.

Additionally, it is imperative that each country take into account the psychological effect that empirical evidence may have on the fact finder when determining whether secondary meaning in a niche mark has been acquired. Finders of fact often intuitively overemphasize product sales volume and scale of advertising when determining if secondary meaning exists in a mark.<sup>131</sup> However, in the past several years, many niche businesses and small-scale companies have taken advantage of our global village as a way to sell their goods

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129. *Frequently Asked Questions: Vienna Classification*, WIPO, <http://www.wipo.int/classifications/vienna/en/faq.html> (last visited Nov. 15, 2015) (click the “How many trademark offices use the VCL?” link).

130. *Id.*

131. *See, e.g.,* President & Trs. of Colby Coll. v. Colby Coll.-N.H., 508 F.2d 804, 808 (1st Cir. 1975) (“[W]hile secondary meaning is shown by the success rather than by the mere fact of an enterprise’s promotional efforts, the normal consequence of substantial publicity may be inferred.” (citation omitted)); 104 N.Y. JUR. 2D *Trade Regulation* § 174 (2015) (“Large expenditures for advertising tend to support the acquisition of a secondary meaning. . . . [Whereas] the lack of expenditure for advertising tends to disprove the acquisition of a secondary meaning.”); *see also* Alyssa Morrison, *The Advertising Factor in the Secondary Meaning Instruction*, 19 J. CONTEMP. LEGAL ISSUES 296, 300 (2010) (describing the amount spent on advertising as an indirect form of evidence of secondary meaning).

internationally, even with limited funding. In fact, marketing strategists have acknowledged that, in this era of fragmented advertising platforms, advertising can become less expensive, and more influential, for companies with a strong brand.<sup>132</sup> If judges and juries continue to gravitate toward empirical data and advertising expenditures, obscure niche companies will not be given a fair opportunity to demonstrate acquired distinctiveness, even if the company has received notable recognition in online customer testimonies, blog reviews, and specialized markets. Furthermore, there are no bright line rules in trademark law for determining if secondary meaning exists, specifically to aid companies in protecting their marks, regardless of the mark's mainstream popularity or widespread use. Due to the vast exposure that a product can achieve on the Internet, courts should return to assessing the effect or success of a mark<sup>133</sup>—rather than the fact that large advertising budgets were exploited—to determine whether a brand has acquired distinctive force.

Lastly, courts should urge litigants to obtain conclusive and in-depth consumer surveys via the Internet. In our global economy, it is not enough to search for customer recognition in physically and geographically confined areas. Because so many companies are beginning to sell their goods exclusively on the Internet, courts will not be fully informed on how far-reaching a company's brand recognition is unless it makes an effort to understand consumers via the appropriate universe—online platforms—where purchasers most often interact with the brand.<sup>134</sup> By taking these steps, international efforts to harmonize trademark laws and foster fair competition will be satisfied.

Until secondary meaning requirements can be fairly balanced, the protection of color per se will remain a privilege primarily for wealthy international conglomerates. Additionally, due to the trend of international companies moving from a multidomestic marketing approach to a global marketing approach,<sup>135</sup> many corporations are turning to litigation to protect their investments and global images in

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132. Swann, Sr. et al., *supra* note 19, at 808.

133. See, e.g., *Echo Travel, Inc. v. Travel Assocs., Inc.*, 870 F.2d 1264, 1270 (7th Cir. 1989) (asserting that evidence of advertising success was more influential than evidence of advertising volume).

134. See *T-Mobile US, Inc. v. AIO Wireless LLC*, 991 F. Supp. 2d 888, 907 (S.D. Tex. 2014) (“In an infringement action, the appropriate universe should include a fair sampling of those purchasers most likely to partake of the alleged infringer’s goods or services.”) (quoting *Scott Fetzer Co. v. House of Vacuums Inc.*, 381 F.3d 477, 487–88 (5th Cir. 2004)).

135. Isabelle Schuiling & Jean-Noël Kapferer, *Executive Insights: Real Differences Between Local and International Brands: Strategic Implications for International Marketers*, 12 J. INT’L MARKETING 97, 97 (2004).

foreign jurisdictions. Unfortunately, until these corporations stop using their deep pockets to coerce smaller companies from utilizing color branding, new market entrants and small-scale companies will continue to operate at a disadvantage in the global marketplace. A countervailing response to this Note's proposal (to balance the secondary meaning requirement) may be that the requirement as it stands aids in preventing color depletion from manifesting in global markets by barring competitors from participating in the market. However, the principle of limiting the secondary meaning requirement reflects the policy of trademark law: ensuring fair competition among market participants. By allowing small companies to compete effectively in the market, a modified secondary meaning requirement will meet the requirement's original objectives of protecting against consumer confusion by providing adequate and fair hurdles to all competitors. Under this scheme, color depletion will be impeded through the fair competition of market participants and will not frustrate the policy goals of trademark law.

#### V. THE IMPORTANCE OF NONVERBAL INDICATORS IN A GLOBAL MARKET: MAKING THE ARGUMENT FOR COLOR PROTECTION ON AN INTERNATIONAL SCALE

Despite the hurdles that industry newcomers will have to face when battling color depletion in our rapidly globalizing trade markets, the importance of protecting nonverbal indicators outweighs the current frustration in global competition. Current Canadian IP efforts to adopt the Madrid Protocol illustrate the importance of fully protecting brands: to continue without such protection would cause largely multicultural countries to stifle market growth as compared to international best practices.<sup>136</sup> It has been demonstrated in cross-national brand studies that companies tend to expand into neighboring markets, as well as into markets that share the same culture, before embarking into geographically and culturally foreign markets.<sup>137</sup> By first establishing a brand image in home markets, companies can acquire secondary meaning that will then hopefully permeate into foreign commerce through consumer testimony, media recognition, and reputational

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136. See Ashley Dumouchel, *The Chances of Canada Finally Joining the Madrid System*, MONDAQ (Nov. 4, 2014), <http://www.mondaq.com/canada/x/351732/Trademark/The+Chances+Of+Canada+Finally+Joining+The+Madrid+System>.

137. See Janell D. Townsend et al., *Getting to Global: An Evolutionary Perspective of Brand Expansion in International Markets*, 40 J. INT'L BUS. STUD. 539, 544 (2009) (asserting that empirical studies indicate that companies view cultural differences as an important barrier to foreign-market entry).

standing. This in turn influences the emergence of the global consumer: as communication and information continue to cross national boundaries, admiration for foreign cultures will positively affect brand recognition and consumption in foreign markets. For example, the admiration and imitation of Western culture has directly affected consumerism in India through the consumption of and deference to Bollywood films<sup>138</sup>—many Bollywood films depict globetrotters and Western-educated protagonists, which has influenced attitudes and perceptions of brands associated with Western culture. Results in surveys have revealed that Indians are now becoming more interested in the practice of international consumption,<sup>139</sup> which has led to an invasion by Western brands of the Indian luxury market.<sup>140</sup>

Because of the rapid expansion of the luxury market in countries such as India and China, the importance of protecting color marks has become even more urgent. It is imperative that companies be able to protect their brands in foreign markets.<sup>141</sup> Furthermore, due to the emergence of brand communities (in which a group of consumers controls a brand image separately and distinctly from the owner of the mark), international consumers can help establish secondary meaning in color marks through guerrilla marketing and personal testimonies—before the company even attempts to participate in that market.<sup>142</sup>

Finally, globalization has directly lent itself to creating significant ethnic and cultural diversification in the United States and abroad. Supporters of the Qualitex Company recognized this as an important ground for abolishing the mere color rule. It was stated in several amicus briefs that our world was in the midst of a multitude of human

138. See generally Gayatri Rangachari Shah, *Bollywood Takes Some Style Cues*, INT'L HERALD TRIB., Oct. 5, 2011, at 12 (describing the trend of Western brands infiltrating Bollywood films).

139. See Michelle R. Nelson & Sameer Deshpande, *The Prevalence of and Consumer Response to Foreign and Domestic Brand Placement in Bollywood Movies*, 42 J. ADVER. 1, 1 (2013).

140. See, e.g., *Indian Luxury Market—An Appraisal*, INDIA BIZNEWS (Feb. 16, 2012), <http://www.indiabiznews.com/?q=node/2401> (attributing the rise in luxury consumption partly to the proliferation of brands such as Aston Martin and Hermes); CONFEDERATION INDIAN INDUS. & A.T. KEARNEY, *LUXURY IN INDIA: CHARMING THE SNAKES AND SCALING THE LADDERS*, at v (2010) (discussing future growth in the Indian luxury market).

141. A significant portion of the luxury market is attributed to the fashion industry, in which colors are regularly ascribed to particular brands and designers (i.e. Louboutin and his red-soled shoes; Hermes' orange leather; Tiffany's blue boxes; Veuve Clicquot and its orange-labeled champagne bottles; Betsey Johnson's fluorescent pink accents on jewelry and shoes).

142. Cf. Deven R. Desai, *From Trademarks to Brands*, 64 FLA. L. REV. 981, 1000 (2012) (discussing the relational brand theory, which views customers and brands as equal players in a relationship).

diversity, and “[t]he diversity of American citizens based upon language, culture, age, education . . . [made] universally comprehensible communication virtually impossible,”<sup>143</sup> and called for the emergence of the universal language of color as a communicating mark to further our progress. Color is one of the few modes of communication that transcend language barriers, and has become essential in a global community where it is inevitable that humans will migrate and travel to foreign countries. Just as trademarks were originally useful to populations migrating from villages to cities to recognize goods,<sup>144</sup> color trademarks can now act as indicators of source in foreign markets, regardless of whether the label is written in a language that the consumer can understand. Furthermore, if companies cannot expect to receive protection for their color trademarks when entering foreign markets, consumer needs (especially of immigrant sectors) will not be met.

### CONCLUSION

When *Qualitex* was decided almost twenty years ago, the legal community focused on the possible consequences and repercussions the case would have in commercial markets. Many observers, however, did not realize that the U.S. dry cleaning industry was illustrative of how globalization in the Internet age was about to change the way consumers participated in commerce. Consumers are now more open than ever to purchasing and subscribing to foreign brands. Because we have yet to achieve a global language, the importance of color in signifying goods plays an integral part in the way consumers identify particular goods.

Since the 1990s, technological innovations in the communications and color industries have helped resolve major problems surrounding color depletion. This Note argues that the best resolution for international color depletion and frustration of competition may be to apply a wait-and-see attitude: just as subsequent cases in the past twenty years helped alleviate these issues in local markets, by utilizing color classification systems future decisions in transnational color mark cases may help expand the breadth of the spectrum available in international markets and bring clarity to the judicial process. Furthermore, by placing less emphasis on substantial advertising expenditures, newcomers and small-scale businesses will be able to participate freely in global trade. The rise of the global consumer and

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143. Brief of Dr Pepper, *supra* note 23, at 15.

144. See Deven R. Desai & Spencer Waller, *Brands, Competition, and the Law*, *BYU L. REV.* 1425, 1444 (2010).

brand communities will also help establish secondary meaning in foreign markets before conglomerate corporations create any significant harm to small-scale players. By relying on telecommunications, brand communities, and the global consumer, color marks will have the opportunity to transcend physical boundaries via the increasing density of cultural interconnections and help establish new enterprises in foreign markets. Moreover, it is recommended that the United States and members of the Vienna Classification System follow precedent set by the EU and require trademark applicants to submit a color code from an international color identification system. Under these recommendations, it can be possible to effectively combat color depletion and prevent David-and-Goliath-esque trademark wars from continuing in global trade.